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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,249	03/25/2004	Timothy P. McKee	MSFT122022	6683
26389 7590 09/12/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
EXAMINER				
WU, QING YUAN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,249

Applicant(s)

MCKEE ET AL.

Examiner

Qing-Yuan Wu

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-15, 17-22, 25-33, 35, 37-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, 17-22, 25-33, 35, 37-40, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-6, 9-15, 17-22, 25-33, 35, 37-40, 42 and 43 are pending in the application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17-22, 25-33, 35, 37-40 and 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 17 is a system claim directed to software alone without claiming associated computer hardware required for execution (i.e. components are described as software programs in the specification [PG Pub 2004/0194116, paragraph 41]), therefore is non-statutory. The examiner suggests incorporating hardware components such as memory/processor/hardware devices as part of the system to overcome the current rejection. As to claims 18-22, these are dependent claims of claim 17 and failed to satisfy the hardware requirement of claim 17, therefore they are rejected for the same reason.
5. As to claims 25-33 and 35, these claims are rejected for the same reason as claims 17-22 above.

6. Claims 37-40 and 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because they are lacking utilities. More specifically, these claims recite the limitation “computer-readable media...comprising computer-usable instructions” but failed to indicate what permits the computer-usable instruction to be realized (i.e. computer executable code or program must be stored in a computer-readable medium, and executed by a computer element to perform control of a technical procedure). See MPEP 2106.01.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 25-33 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lacks antecedent basis:

i. the sender- claims 25 and 37.

b. The following terms are indefinite:

i. As per claim 25, it is uncertain whether “a notification” on lines 5-6 and 8 refer to “a notification” on line 3 (i.e. If they are the same then “said” or “the” should be used, and “the notification” should be used throughout the claim). For examination purpose, they would be treated as the same for the remainder of this office action.

There are too many error to list individually, applicant is reminded to use consistent term to properly refer to the antecedent and fix all errors in the amendment.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6, 9-15, 17-20, 22, 25-30, 32, 35, 37-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (U.S. PG Publication 2003/0229722), in view of Hinckley (U.S. Patent 5,828,882).

11. As to claim 1, Beyda teaches a method comprising:

when a communication event occurs, evaluating a sender according to selected criteria to determine whether a software process will send a customized message to the sender, wherein the evaluation of the sender comprises a determination of whether or not the sender has been placed on a list of person entitled to received the customized message [rules that determines whether or not a response message is sent to senders in certain group, paragraphs 45-49; paragraph 35, lines 5-14; Fig. 3].

12. Beyda does not specifically teach the software process as a registered process, more

specifically, a process being registered as a result of receiving a message to register the process for communication events. However, Hinckley teaches receiving registration requests from programs and consequently registering the programs for event notification [Hinckley, Col. 4, lines 39-56].

13. Beyda teaches a timer event which provides notification for the middleware to implement or activate the designated rules and a keystroke or mouse movement event that prevents such implementation or activation of the designated rules [paragraph 39]. Hinckley teaches registering process for event occurrence notifications and providing notifications upon detecting such event occurrences [Hinckley, Col. 4, lines 39-56]. Because both Beyda and Hinckley teaches methods for providing notifications, it would have been obvious to one of ordinary skill in the art to substitute one method for another to achieve the predictable result of providing notifications to the proper notification consumer.

14. As to claim 2, Beyda as modified teaches wherein one type of communication event occurs when a notification from a sender is not delivered to a user due to the user's context [deleting the instant message when message not read or opened even when user is online, paragraph 2, lines 15-22; paragraphs 35 and 39].

15. As to claim 3, Beyda as modified teaches wherein the software process is a program that has data regarding the user that is outside the data that is maintained by the other components of the system [software program for determining rules has data regarding the user (i.e. availability

of user based on time elapsed) is separate from instant message client software, paragraphs 37 and 39].

16. As to claim 4, Beyda as modified teaches wherein in response to receiving a communication event, the software process may provide a customized message to the sender of the notification that includes data about the user [paragraph 37].

17. As to claim 6, Beyda as modified teaches wherein the data about the user includes at least one alternative contact for the user [email, facsimile, etc., paragraph 37].

18. As to claim 9, this claim is rejected for the same reason as claim 1 above. In addition, Beyda as modified teaches sending a message for registering a process, providing the registered process with information regarding the communication event [in the perspective of the program requesting to registering to receive events, Hinckley, col. 4, lines 39-56].

19. As to claim 10, this claim is rejected for the same reason as claim 1 above [reception of the instant message, Beyda, paragraphs 45-49; paragraph 35, lines 5-14; Fig. 3].

20. As to claim 11, Beyda as modified teaches wherein the information regarding the communication event indicates that the notification did not reach the user [message not read by user did not reach the user an indication that the user is not available, paragraphs 35-37; Fig. 3].

21. As to claim 12, this claim is rejected for the same reason as claim 9 above.
22. As to claim 13, this claim is rejected for the same reason as claim 3 above.
23. As to claim 14, this claim is rejected for the same reason as claim 11 above.
24. As to claim 15, this claim is rejected for the same reason as claim 4 above.
25. As to claim 17, this claim is rejected for the same reason as claim 1 above. In addition, Beyda as modified teaches a sending component, receiving component which receives the notifications and under specified conditions delivers the notifications to a user [send and received IMs, paragraph 27; some non-read or non-opened are deleted, paragraph 35; Fig. 3].
26. As to claims 18-20 and 22, these claims are rejected for the same reason as claims 2-4 and 6 above.
27. As to claim 25, this claim is rejected for the same reason as claims 1 and 17 above. In addition, Beyda as modified teaches a process for setting a user context [paragraph 2, lines 15-22].
28. As to claim 26, Beyda as modified teaches wherein the second process is a communication program [instant message client software operating on user devices generate or

receive instant messages, paragraphs 27 and 33].

29. As to claim 27, this claim is rejected for the same reason as claim 26 above.

30. As to claims 28-30 and 35, these claims are rejected for the same reason as claims 3-4, 14 and 25 above.

31. As to claim 32, Beyda as modified teaches the user context that is set by the first process indicates when the user is not available to interruption [when user does not sign-on to indicate online presence, paragraph 2, lines 15-22].

32. As to claims 37-40 and 42, these claims are rejected for the same reason as claims 2, 25 and 4 above.

33. Claims 5, 21, 31, 33 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda and Hinckley as applied to claims 1, 9, 17, 25 and 37 above, in view of Cahill (U.S. Patent 5,428,784)

34. As to claim 5, Beyda and Hinckley does not specifically teach wherein the software process is a calendaring program and the data about the user indicates a time when the user may next be available. However, Cahill teaches checking an electronic calendar and notifying a sender the receiver's availability [Cahill, col. 3, lines 14-44]. It would have been obvious to one

of ordinary skill in the art at the time the invention was made to have modified the teaching of Beyda and Hinckley with the teaching of Cahill to further enhance the sender notification method of Beyda and Hinckley [Beyda, paragraph 4] by providing more detail status information about the receiver upon receiving the sender's message as being considered by Cahill to address the unnecessary anticipation of an unavailable receiver [Cahill, col. 1, lines 51-59].

35. As to claims 21 and 31, these claims are rejected for the same reason as claim 5 above.

36. As to claim 33, this claim is rejected for the same reason as claims 2 and 5 above.

37. As to claim 43, this claim is rejected for the same reason as claim 5 above.

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,175,859 to Mohler, U.S. PG Publication 2003/0014491 to Horvitz et al., U.S. PG Publication 2005/0138108 to Galvin, JR. et al. teach inferring or communication message receiver availability to message sender.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qing-Yuan Wu whose telephone number is (571)272-3776. The examiner can normally be reached on 8:30am-6:00pm Monday-Thursday and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Meng-Ai An/
Supervisory Patent Examiner, Art Unit 2195

/Qing-Yuan Wu/
Examiner, Art Unit 2194